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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,984	03/24/2004	Mari Ichimura	09792909-5829	4456

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EXAMINER
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GARRETT, DAWN L

ART UNIT	PAPER NUMBER
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1794

MAIL DATE	DELIVERY MODE
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12/14/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/807,984	<b>Applicant(s)</b> ICHIMURA ET AL.	
	<b>Examiner</b> Dawn Garrett	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 27-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 27-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>5-2-07; 7-18-07</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Response to Amendment***

1. This Office action is responsive to the amendment filed October 17, 2007.  
Claims 1, 2, 7, and 8 were amended. Claims 10-26 are canceled. Claims 27-32 have been added. Claims 1-9 and 27-32 are pending.
2. The rejection of claims 1, 2, and 6-9 under 35 U.S.C. 102(a) as being anticipated by Tamura et al. (JP 2002-246175) is withdrawn due to the amendment.
3. The rejection of claims 1-9 under 35 U.S.C. 102(e) as being anticipated by Ishibashi et al. (US 2002/0106530 A1) is withdrawn due to the amendment.
4. The rejection of claims 1-9 under 35 U.S.C. 102(e) as being anticipated by Ishibashi et al. (US 2003/0099863 A1) is withdrawn due to the amendment.
5. The rejection of claims 1, 2, and 6-9 under 35 U.S.C. 102(e) as being anticipated by Ichimura et al. (US 6,492,557 B1) is withdrawn due to the amendment.
6. The rejection of claims 1-9 under 35 U.S.C. 102(e) as being anticipated by Ishibashi et al. (US 6,555,254 B1) is withdrawn due to the amendment.
7. The rejection of claims 1-9 under 35 U.S.C. 102(e) as being anticipated by Ishibashi et al. (US 6,800,382 B1) is withdrawn due to the amendment.
8. The rejection of claims 1-9 under 35 U.S.C. 102(b) as being anticipated by Tadashi et al. (US 6,265,088 B1) is withdrawn due to the amendment.
9. The rejection of claims 1-9 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, and 8-11 of U.S. Patent No. 6,800,382 B2 is withdrawn due to the amendment.

10. The rejection of claims 6-9 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,492,557 B1 is withdrawn due to the amendment.

11. The rejection of claims 1-9 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,265,088 B1 is withdrawn due to the amendment.

### ***Claim Objections***

12. Claims 2 and 8 are objected to because of the following informalities:

Both claims 2 and 8 contain two occurrences of a period after the word "stylyl" in the middle of the claims. A period should only occur at the end of the claim. See pages 4, 5, 16 and 17 of the last claim amendment. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

13. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

14. Claims 1-9 and 27-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Each of claims 1, 2, 7 and 8 (all other claims depend from these and are included in the rejection) comprise the new negative limitation "but R<sup>f</sup> is not a stylyl", "but R<sup>5</sup> is

not a stylyl", "but R<sup>15</sup> is not a stylyl" or "but R<sup>27</sup> is not a stylyl". Applicant states that the claim amendment is supported by the specification. The examiner has not located the term or the definition of the term "stylyl" in the specification. In addition, there are no formulas shown comprising a "stylyl". In order for applicant to exclude something by a negative limitation statement, applicant has to show possession of the excluded subject matter, especially within the same scope as recited in the claim. Support for not having a "stylyl group" has not been found in the specification.

15. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 depends from claim 8, which does not define formulas (5)-(17) and makes the claim indefinite. Claim 9 does not depend from claim 6 and should not refer back to claim 6 for the definition of formulas (5)-(17). Claim 9 ultimately depends from claims 7 and 8 while claim 6 depends from 1 and 2. Formulas (5)-(17) should be set forth in claim 9 and clearly defined.

### ***Response to Arguments***

16. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

The previous prior art rejections have all been withdrawn due to the amendment. It is noted that the amendment caused the rejection under 35 U.S.C. 112, first

paragraph for new matter as set forth above. If the added limitation to the claims is deleted, the prior art may again be applied to the claims. [The claims were previously rejected over the prior art, because the claims set forth a substituted or unsubstituted *saturated* alkyl group.]

***Allowable Subject Matter***

17. The claims are considered to comprise allowable subject matter; however, all claims are currently rejected under 35 U.S.C. 112, first paragraph. In particular, new claims 27-32 appear to be distinguished over the previously applied prior art.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dawn Garrett whose telephone number is (571) 272-1523. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dawn Garrett/

Dawn Garrett  
Primary Examiner  
Art Unit 1794